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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/026,824	02/20/98	WINFREE R	TACOBEL.010A

PM11/0311

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EXAMINER	
BARTUSKA,F	

ART UNIT	PAPER NUMBER
3652	5

DATE MAILED: 03/11/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/026,824	WINFREE et al.
Examiner	**Group Art Unit**
F. J. BARTUSKA	3652

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on FEB. 20, 1998.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-48 is/are pending in the application.

Of the above claim(s) 32-43 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-30 AND 44-48 is/are rejected.

☒ Claim(s) 31 is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-31 and 44-48, drawn to a food preparation assembly, classified in class 186, subclass 38.

   II. Claims 32-34, drawn to a steam cabinet, classified in class 99, subclass 476.

   III. Claims 35-39, drawn to an ingredient dispenser, classified in class 221, subclass 174.

   IV. Claims 40-42, drawn to a hanging storage system, classified in class 99, subclass 467.

   V. Claim 43, drawn to a method of preparing a food product, classified in class 426, subclass 665.

2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II-IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because: in the case of I and II, the combination does not require swing doors; in the case of I and III, the combination

does not require a positive displacement pump; and in the case of I and IV, the combination does not require a hole in a horizontal member so as to allow access into the container. The subcombinations have separate utility such as use at any location not just a food preparation line.

3. Inventions II, III, and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions II, III, and IV have separate utility such as for use in separate food preparation fields. See MPEP § 806.05(d).

4. Inventions V and I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have differenct functions.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with William Shreve on December 9, 1998 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-31 and 44-48. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7, 10, 13-18, 20, 21, 29 and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tuhro et al. Tuhro et al show a food preparation line with three sections including a heated storage compartment 22 in the first section, a cooled storage compartment 24 in the second section, a refrigerator 35a and a package storage compartment 33.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to

which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuhro et al in view of Conlon et al. Tuhro et al show all the features of the applicants' claimed invention except the cooking unit. It would have been obvious to one of ordinary skill in the art in view of the cooking unit 28 of Conlon et al to provide the device of Tuhro et al with a cooking unit to permit cooking as a part of the food preparation.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuhro et al in view of Searcy. Tuhro et al show all the features of the applicants' claimed invention except the sections being arranged in a U shape. It would have

been obvious to one of ordinary skill in the art in view of the U-shaped arrangement of the food preparation area 14 of Searcy to arrange the sections of Tuhro et al in the more space efficient U shape.

6. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuhro et al. Tuhro et al show all the features of the applicants' claimed invention except the diagnostic system. Merely calling for temperature sensors and controls in a device with heating elements would appear to involve only notorious expedients in the art.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuhro et al in view of Baze. Tuhro et al show all the features of the applicants' claimed invention except the taco rail. It would have been obvious to one of ordinary skill in the art in view of the taco rail of Baze to provide the device of Tuhro et al with a taco rail to permit the preparation of tacos.

8. Claims 19 and 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuhro et al in view of Boyd et al. Tuhro et al show all the features of the applicants' claimed invention except the cup dispenser. It would have been obvious to one of ordinary skill in the art in view of the cup dispensers 56 of Boyd et al to provide the device of Tuhro et al with a cup dispenser to provide cups to contain the food.

9. Claims 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuhro et al in view of Conlon et al. Tuhro et al show all the features of the applicants' claimed invention except the ingredient dispensers. It would have been obvious to one of ordinary skill in the art in view of the ingredient dispensers 52 and 54 of Conlon et al to provide the device of Tuhro et al with ingredient dispensers to aid the food preparation.

10. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuhro et al in view of Conlon et al as applied to claim 25 above, and further in view of Pinckard. Tuhro et al, as modified by Conlon et al, show all the features of the applicants' claimed invention except the heated shelf. It would have been obvious to one of ordinary skill in the art in view of the heated shelf 48 of Pinckard to provide the device of Tuhro et al with a heated shelf to keep the food warm.

11. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuhro et al in view of Boyd et al as applied to claim 47 above, and further in view of Searcy. Tuhro et al, as modified by Boyd et al, show all the features of the applicants' claimed invention except the sections arranged in a U shape. It would have been obvious to one of ordinary skill in the art in view of the U-shaped arrangement of the food preparation area 14 of Searcy to arrange the food preparation area of Tuhro et al in the more space efficient U shape.

Claim Rejections - 35 USC § 112

12. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim is indefinite because there is not proper antecedent basis for "the taco rail". Shouldn't claim 12 depend from claim 11?

Allowable Subject Matter

13. Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. Bartuska whose telephone number is (703) 308-1111.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen Young, can be reached on (703) 308-1107. The fax phone number for this Group is (703) 305-7687.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**karen.young@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified exchanged unless there is of record an express waiver of the confidentiality requirements of 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published in the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

F. J. BARTUSKA
PRIMARY EXAMINER
GROUP 3100

3/9/99